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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER PHAAL

Appeal 2008-3084¹
Application 09/850,202
Technology Center 2400

Decided:² April 21, 2009

Before JOHN C. MARTIN, JOSEPH L. DIXON, and
JEAN R. HOMERE, Administrative Patent Judges.

HOMERE, Administrative Patent Judge.

DECISION ON APPEAL

¹ Filed May 7, 2001. The real party in interest is Inmon Corporation.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from a final rejection of claims 1 through 19 and 26 through 32. Claims 20 through 25 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

Brief Summary of the Invention

Figure 3 is reproduced below:

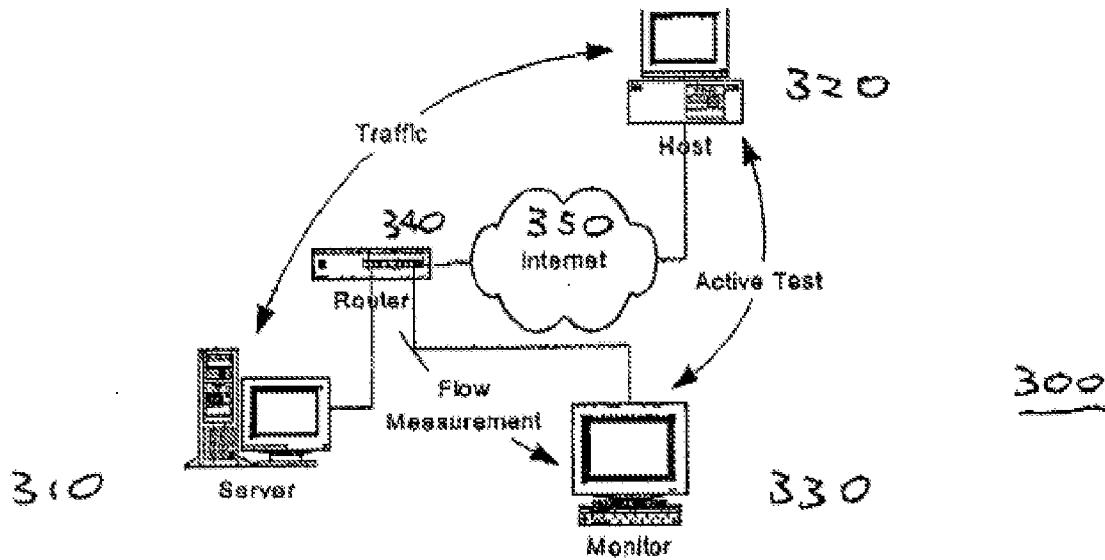


Figure 3 Elements of Monitoring System

As depicted in Figure 3, Appellant invented a method and apparatus for gathering and analyzing test results within a network (300), wherein a

server (310) communicates with a host (320) via a router (340). Particularly, the router (340) filters data packets originating from the server (310). The router (340) then generates and sends a flow record containing the destination and source information of each filtered data packet to a monitor (330) for further analysis and testing. The monitor (330) randomly selects at least a fraction of the flow records received from the router (340) to then extract the destination and source information. Using the source and destination information, the router (340) can perform active network tests to the remote hosts (320). (Spec. 7).

Illustrative Claim

Independent Claim 1 further illustrates the invention. It reads as follows:

1. A method for monitoring a network, comprising:
 - receiving data packet flow records from at least one network router;
 - filtering said flow records;
 - extracting packet information from said filtered flow records, wherein said extracted packet information comprises information of at least one target of interest; and
 - performing active measurements of said at least one target of interest based on said extracted packet information.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Bruins	US 6,308,148	Oct. 23, 2001
Merriam	US 6,587,878	Jul. 1, 2003

Rejection on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1-19 and 26-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bruins and Merriam.

Examiner's Findings and Conclusions

1. The Examiner avers that the combination of Bruins and Merriam renders independent claim 1 unpatentable. Particularly, the Examiner finds that Bruins' disclosure of a router collecting and aggregating flow information teaches the claimed receiving data packet flow records from at least one network router. (Ans. 7). Further, the Examiner finds that Bruins' disclosure of aggregating information to one or more filters teaches filtering said flow records. (Ans. 7). Additionally, the Examiner finds that Bruins' disclosure of each filter parsing the flow data packets and identifying useful information, such as message flows having a selected range of source addresses, teaches the claimed limitation of extracting packet information from said filtered flow records, wherein said extracted packet information comprises information of at least one target of interest. (Ans. 7-8).

2. The Examiner readily admits that Bruins does not teach performing active measurements of said at least one target of interest based

on said extracted packet information. (Ans. 8). However, the Examiner finds that Merriam's disclosure of a performance measurement program, including a performance test at a particular remote probe, teaches performing active measurements of said at least one target of interest based on said extracted packet information. (Ans. 8).

3. The Examiner concludes that the combination of Bruins and Merriam renders claim 1 unpatentable. Particularly, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bruins' method of extracting packet information from the filtered flow records with Merriam's performance measurement program in order to improve network performance by measuring and using the actual performance time information to fix unacceptable delays. (Ans. 8). The Examiner finds sufficient motivation in both Bruins and Merriam for the proffered combination. (Ans. 9). Specifically, The Examiner finds that Bruins explicitly discloses such a motivation by suggesting modifying a performance parameter of the router in order to improve performance of the router based on aggregated message flow information. (Ans. 9). Further, Merriam discloses using actual performance time information to provide an accurate estimate of delays a consumer may experience, thereby allowing a merchant or others to avoid losing customers by addressing unacceptable delays. (Ans. 9).

Appellant's Contentions

1. Appellant contends that the Examiner erred in concluding that the combination of Bruins and Merriam renders independent claim 1

unpatentable. Particularly, Appellant argues that the rationale for the combination proffered by the Examiner cannot properly be relied upon to establish the *prima facie* case of obviousness. (App. Br. 7-8).

II. ISSUES

1. Has Appellant shown that the Examiner erred in concluding that Bruins and Merriam renders claim 1 unpatentable? Particularly, the issue turns on whether the ordinarily skilled artisan would have found sufficient motivation to combine Bruins' method of extracting packet

information from the filtered flow records with Merriam's performance measurement program in order to improve the performance of a network, as recited in independent claim 1.

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Appellant's Invention

1. Upon filtering data packets and generating respective flow records, a network monitor can randomly select flow records containing destination and source information, thus enabling a router to perform active network tests to remote hosts. (Spec. 7, ll. 9-17).

2. It is an objective of the present invention to provide a network monitoring system that both monitors the most active network paths and automatically selects target sites for monitoring. (Spec. 5, ll. 1-7).

Bruins

3. Bruins discloses techniques for analyzing message flow patterns by exporting and using data related to information flow within a network. (Col. 1, ll. 16-19).

4. Bruins discloses a system for exporting data responsive to information flow patterns whereby the stored aggregated flow information is communicated to an application program for use in modifying a performance parameter of the router. (Col. 8, ll. 12-15). The respective modification of a performance parameter improves the performance of the router. (Col. 8, ll. 16-18).

5. Application programs that use flow data are capable of identifying useful information in the flow data and may either (1) present the useful information to an operator for review, or (2) use the useful information to adjust features or parameters of the network. (Abstract).

Merriam

6. Merriam discloses a method, system, and program for measuring client performance in network systems, specifically the Internet. (Col. 1, ll. 7-10).

7. Merriam discloses using actual performance time information to provide an accurate estimate of delays a consumer may experience, thereby allowing a merchant or others to avoid losing customers by addressing unacceptable delays. (Col. 3, ll. 1-18, and col. 5, l. 66 through col. 6, l. 16).

IV. PRINCIPLES OF LAW

Burden on Appeal

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Obviousness

A claimed invention is not patentable if the subject matter of the claimed invention would have been obvious to a person having ordinary skill in the art. 35 U.S.C. § 103(a); *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 3 (1996).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR, 127 S. Ct. at 1734.

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3)

the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham*, 383 U.S. at 17-18. *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. *KSR*, 127 S. Ct. at 1739.

In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248” (*Id.* (citing *Graham*, 383 U.S. at 12)); and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

If the claimed subject matter cannot be fairly characterized as involving a simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Such a showing requires the Examiner provide “some articulated reasoning” in the rejection, which possesses a “rational underpinning to support the legal conclusion of obviousness.” *Id.* at 1741 (quoting *In re Kahn*, 441 F.3d at 988). The Supreme Court, citing *Kahn*, 441 F.3d at 988, stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 127 S. Ct. at 1741. However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

It is a basic principle that the question under 35 U.S.C. § 103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. *See Merck & Co. Inc., v. Biocraft Labs., Inc.*, 874 F.2d 804, 807 (Fed. Cir. 1989).

Nor is it necessary that the suggestion or motivation be found within the four corners of the references themselves. “The test for obviousness is not whether the features of a secondary reference may be bodily

incorporated into the structure of the primary reference Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). "The obviousness analysis cannot be confined by the formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of ... the explicit content of issued patents." *KSR*, 127 S. Ct. at 1741.

Consistent with *KSR*, the Federal Circuit recently recognized that "[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not." *Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007). The Federal Circuit relied in part on the fact that Leapfrog had presented no evidence that the inclusion of a reader in the combined device was "uniquely challenging or difficult for one of ordinary skill in the art" or "represented an unobvious step over the prior art." *Id.* at 1162.

V. ANALYSIS

Appellant presents a single argument for all the claims pending in this appeal. Specifically, Appellant argues that the combination of Bruins and Merriam does not render claims 1-19 and 26-32 unpatentable. In accordance with 37 C.F.R. § 41.37 (c)(1)(viii), claims 2-19 and 26-32 stand and fall with claim 1.

Independent claim 1 recites in relevant part performing active measurements of one target of interest based on packet information extracted therefrom. As set forth in the Findings of Fact section, Bruins discloses a method and apparatus for receiving, filtering, and analyzing message flow patterns by exporting and using data related to information flow within a network. (FF. 3, 4). Further, Merriam complements Bruins by disclosing a method for measuring client performance in network systems. (FF. 5). We find that Bruins and Merriam disclose prior art elements that perform their ordinary functions to predictably result in a system that actively monitors components in a network to thereby enhance its respective performance.

See KSR, 127 S. Ct. at 1740.

Assuming that the Examiner must articulate some additional reasoning for combining the references, we find that the Examiner has provided ample reasoning to justify the proffered combination. Particularly, the Examiner explained that it would have been obvious to one of skill in the art at the time of the invention to incorporate Bruins' method of extracting packet information from the filtered flow records with Merriam's performance measurement program in order to improve network performance. (FF. 4, 5). The Examiner also explained that it would have been obvious to incorporate Bruins' method of extracting packet information from the filtered flow records with Merriam's performance measurement program in order to use actual measured performance time information to fix unacceptable delays. (FF 7). We therefore agree that the Examiner has provided a sufficient motivation to warrant the proffered combination. It

follows that Appellant has not shown that the Examiner erred in concluding that the ordinarily skilled artisan would have found sufficient motivation to combine Bruins' method of extracting packet information from filtered flow records with Merriam's performance measurement program in order to improve the performance of a network, as recited in independent claim 1.

VI. CONCLUSION OF LAW

Appellant did not demonstrate that the Examiner erred in concluding that an ordinary skilled artisan at the time of the invention would have found sufficient motivation to combine Bruins' method of extracting packet information from the filtered flow records with Merriam's performance measurement program in order to improve performance of a network.

VII. DECISION

We affirm the Examiner's decision to reject claims 1-19 and 26-32.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2008-3084
Application 09/850,202

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